

Serial No. 10/774,440
February 16, 2006
Reply to the Office Action dated November 16, 2005
Page 9 of 12

REMARKS/ARGUMENTS

Claims 1-23 are pending in this application. By this amendment, Applicants AMEND the specification and claim 11.

Applicants greatly appreciate the Examiner's indication that claims 20-23 are allowed, that claims 1-10 would be allowable if rewritten or amended to overcome the 35 U.S.C. § 112, first paragraph, rejection, and that claim 12 would be allowable if rewritten in independent form including all of the features of the base claim and any intervening claims.

Claims 1-19 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Applicants respectfully traverse the rejection of claims 1-19.

The Examiner alleged that the feature "the external electrodes are not disposed in the corners of the top surface of the ceramic substrate" recited in claims 1 and 11 is not discussed in the specification.

It appears that the Examiner intended to object to the specification under 37 C.F.R. § 1.75(d)(1) as failing to provide proper antecedent basis for the claimed subject matter since the feature of "the external electrodes are not disposed in the corners of the top surface of the ceramic substrate" is, at the least, clearly supported by the originally filed drawings, in particular, Figures 1A, 1B, and 2A. The Examiner is reminded that the Applicant may rely upon the drawings as part of the original disclosure. See MPEP § 608.04. Furthermore, the fourth full paragraph on page 5 of the originally filed specification discloses that "[t]he ceramic substrate 10 has external ground electrodes 11 on its front and back surfaces and external electrodes 12 for input/output or grounding on its side surfaces." (emphasis added). Thus, the specification and the drawings clearly provide support for the feature of "the external electrodes are not disposed in the corners of the top surface of the ceramic substrate" as recited in Applicants' claims 1 and 11. Applicants have amended the fourth full paragraph on page 5 of the specification to provide proper antecedent basis for the claimed subject matter under 37 C.F.R. § 1.75(d)(1). Support for this amendment can

Serial No. 10/774,440
February 16, 2006
Reply to the Office Action dated November 16, 2005
Page 10 of 12

be found in, for example, Figures 1A, 1B, and 2A, as originally filed.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-19 under 35 U.S.C. § 112, first paragraph.

Claims 11, 13, 14, 16, and 17 were rejected under 35 U.S.C. § 102(b) as being anticipated by Uchida et al. (U.S. 6,079,099). Claims 15, 18, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Uchida et al. Applicants respectfully traverse the rejections of claims 11 and 13-19.

Claim 11 has been amended to recite:

"An integrated electronic component comprising:
a ceramic substrate including circuit elements and external electrodes disposed on side surfaces of the ceramic substrate; and
a metal case having a top segment and substrate-facing segments and being mounted on the ceramic substrate; wherein
bottom edges of the substrate-facing segments oppose a top surface of the ceramic substrate, the substrate-facing segments have notches at positions opposing corners of the top surface of the ceramic substrate, **and the notches have a substantially convex circular arc shape facing downwardly; and the external electrodes are not disposed in the corners of the top surface of the ceramic substrate.**" (emphasis added)

Support for the above amendment can be found in Figure 4 of the originally filed application. Additionally, Applicants have amended the first full paragraph on page 9 of the specification to provide proper antecedent basis for the claimed subject matter in accordance with 37 C.F.R. § 1.75(d)(1).

First, the Examiner improperly ignored the feature of "the external electrodes are not disposed in the corners of the top surface of the ceramic substrate" as recited in Applicant's claims 1 and 11 in the prior art rejection. MPEP § 706.03(o) clearly provides that, as to any prior art rejection, the alleged "**new matter must be considered as part of the claimed subject matter and cannot be ignored.**" (emphasis added). The Examiner completely failed to address the feature of "the external electrodes are not disposed in the corners of the top surface of the ceramic substrate" in the prior art rejection in the outstanding Office Action.

In the embodiment of Uchida et al. in which the notches are provided at positions

Serial No. 10/774,440
February 16, 2006
Reply to the Office Action dated November 16, 2005
Page 11 of 12

opposing the corners of the substrate 20, the external/terminal electrodes 26 of Uchida et al. are disposed at all four corners of the top surface of the substrate 20. Thus, Uchida et al. fail to teach or suggest the features of "the substrate-facing segments have notches at positions opposing corners of the top surface of the ceramic substrate" and "the external electrodes are not disposed in the corners of the top surface of the ceramic substrate" as recited in Applicants' claim 11.

Although Fig. 4 of Uchida et al. shows an embodiment in which a substrate 320 includes external electrodes 326 that are not disposed in the corners of the top surface of the substrate, in this embodiment of Uchida et al., the notches are not disposed at positions opposing corners of the top surface of the ceramic substrate. In each and every embodiment disclosed in Uchida et al., the notches are disposed at the same location as the external electrodes. Uchida et al. fail to teach or suggest that the notches could or should be located at different locations from the external electrodes.

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 11 under 35 U.S.C. § 102(b) as being anticipated by Uchida et al.

Since the Examiner improperly rejected claims 1-19 under 35 U.S.C. § 112, first paragraph, by ignoring the originally filed drawings for support of the claimed subject matter and improperly ignored the feature "the external electrodes are not disposed in the corners of the top surface of the ceramic substrate" when rejecting claim 11 under 35 U.S.C. § 102(b), **Applicants respectfully request that the Examiner withdraw the Finality of the outstanding Office Action as being premature.** See MPEP §§ 706.07(d), 706.07(e).

Furthermore, claim 11 has been amended to include the feature of "the notches have a substantially convex circular arc shape facing downwardly." (emphasis added)

In contrast, Fig. 1 of Uchida et al. shows notches having a concave shape facing downwardly. Thus, Uchida et al. fails to teach or suggest the feature of "the notches have a substantially convex circular arc shape facing downwardly" as recited in Applicants' claim 11.

Accordingly, Applicants respectfully submit that Uchida et al. fail to teach or

Serial No. 10/774,440
February 16, 2006
Reply to the Office Action dated November 16, 2005
Page 12 of 12

suggest the unique combination and arrangement of elements recited in Applicants' claim 11.

In view of the foregoing amendments and remarks, Applicants respectfully submit that claim 11 is allowable. Claims 12-19 depend upon claim 11, and are therefore allowable for at least the reasons that claim 11 is allowable.

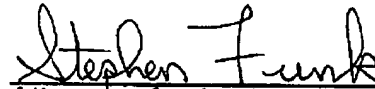
In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Dated: February 16, 2006

KEATING & BENNETT, LLP
8180 Greensboro Drive, Suite 850
Tyson's Corner, VA 22102
Telephone: (703) 637-1480
Facsimile: (703) 637-1499

Respectfully submitted,


Attorneys for Applicant(s)

Joseph R. Keating
Registration No. 37,368

Stephen R. Funk
Registration No. 57,751